

PATENT

Atty. Dkt. No. 2001-0159 (ATT 2001-0159)

REMARKS

In view of the following discussion, the Applicant submits that none of the claims now pending in the application are anticipated or obvious under the provisions of 35 U.S.C. § 102 and § 103. Thus, the Applicant believes that all of these claims are now in allowable form.

I. OBJECTION BECAUSE OF INFORMALITIES

The Examiner objected to reference numerals in the specification (Page 5, 2nd paragraph) that do not appear in any of the figures. Responsive to the Examiner, these reference numerals have been removed from the specification.

II. REJECTION OF CLAIMS 1-6 AND 8 UNDER 35 U.S.C. § 102

The Examiner has rejected claims 1-6 and 8 in the Office Action under 35 U.S.C. § 102 as being anticipated by Cohn et al. (US Patent 66064,723, issued May 16, 2000, hereinafter referred to as "Cohn"). Applicant respectfully traverses the rejection.

Cohn teaches a network-based multimedia communications and directory system and method of operation. (See Cohn, Title.) Specifically, Cohn teaches a communication system that stores the user profiles of subscribers. (See Cohn, Col. 32, Lines 33-37.) The user profiles contain the subscriber's portrait or video of the subscriber, a digitally encoded recording of the subscriber speaking his or her own name, or a graphic image of the subscriber's signature. (See *Id.* at Lines 37-41.) This information is used for identification confirmation to assure the sender the message was sent to the proper recipient. (See *Id.* at Lines 11-17.)

The Examiner's attention is directed to the fact that Cohn fails to teach or to suggest the novel concept of a method of providing electronic mail message return receipts, wherein the electronic mail message originator will be able to view the electronic mail message recipient reading the electronic mail message, as positively claimed by the Applicant. Specifically, Applicant's amended independent claim 1:

1. A method for providing electronic mail message return receipts between at least one electronic mail message originator and at least one electronic mail message recipient, the method comprising:

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receiving an electronic mail message which requires a video enhanced electronic mail message return receipt when received by the at least one electronic mail message recipient;

providing the electronic mail message recipient to the electronic mail message originator, wherein the electronic mail message originator will be able to view the electronic mail message recipient reading the electronic mail message. (Emphasis added.)

In contrast, Cohn merely teaches a system that stores pre-recorded video of subscribers for identification confirmation. (See Cohn, Col. 32, Lines 15-27.) The Examiner's attention is directed to the fact that Cohn does not teach or suggest any method of electronic mail message return receipts or recording video of the recipient each time he or she reads a new electronic mail message. More specifically, Cohn completely lacks any teaching of a method of providing electronic mail message return receipts, wherein the electronic mail message originator will be able to view the electronic mail message recipient reading the electronic mail message. As such, the Applicant respectfully submits that Cohn does not anticipate Applicant's independent claim 1.

Therefore, Applicant respectfully submits that independent claim 1 is clearly patentable and not anticipated by Cohn. Furthermore, dependent claims 2-6 and 8 depend, either directly or indirectly, from claim 1 and recite additional limitations. As such, and for the exact same reason set forth above, the Applicant submit that claims 2-6 and 8 are also patentable and not anticipated by Cohn. As such, the Applicant respectfully requests the rejection be withdrawn.

III. REJECTION OF CLAIMS 7 AND 9-20 UNDER 35 U.S.C. § 103

A. Claim 7

The Examiner has rejected claim 7 in the Office Action under 35 U.S.C. § 103 as being obvious over Cohn in view of "Official Notice." Applicant respectfully traverses the rejection.

The teachings of Cohn have been discussed above. The Applicant respectfully submits that the Examiner has not taken "Official Notice" properly in accordance with MPEP §2144.03 Section A. The Applicant respectfully asserts that, given the fact there

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is no prior art that discloses a method of providing electronic mail message return receipts, wherein the electronic mail message originator will be able to view the electronic mail message recipient reading the electronic mail message, as recited in independent claim 1, the additional limitations in dependent claim 7 are not "well known" or "common knowledge in the art capable of instant and unquestionable demonstration as being well-known." (See MPEP 8th Ed., 2100-136, Right Column, Lines 4-9.) Furthermore, in accordance with MPEP §2144.03, Section C, the Applicant respectfully requests the Examiner to produce authority for his statement.

In arguendo, even if "Official Notice" is proper, the "Official Notice" fails to bridge the substantial gap left by Cohn. Specifically, Cohn simply does not teach or suggest the novel concept of a method of providing electronic mail message return receipts, wherein the electronic mail message originator will be able to view the electronic mail message recipient reading the electronic mail message. Rather, Cohn merely teaches a system that stores pre-recorded video of subscribers for identification confirmation. (See Cohn, Col. 32, Lines 15-27.) This deficiency is not bridged by the "Official Notice" because the "Official Notice" is only in reference to signaling stoppage of filming.

Dependent claim 7 depends from claim 1 indirectly and recites additional limitations. As such, and for the exact same reason set forth above, the Applicant submits that claim 7 is also not made obvious by the teachings of Cohn and the "Official Notice." As such, the Applicant respectfully requests the rejection be withdrawn.

B. Claims 9-11 and 13-20

The Examiner has rejected claims 9-11 and 13-20 in the Office Action under 35 U.S.C. § 103 as being obvious over Cohn in view of Cleron et al. (US Patent 6,223,213, issued April 24, 2001, hereinafter referred to as "Cleron"). Applicant respectfully traverses the rejection.

The teachings of Cohn have been discussed above. Cleron teaches a browser-based email system with user interface for audio/video capture. (See Cleron, Title.) The browser-based email system allows a user to click on a hypertext link to capture video through a video input or television signal. (See Cleron, Col. 5, Lines 32-35.)

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However, Cleron fails to bridge the substantial gap left by Cohn. Specifically, Cleron also fails to teach or suggest the novel concept of a method of providing electronic mail message return receipts, that determines when a electronic mail message recipient has started reading an electronic mail message and takes video of the electronic mail message recipient when the electronic mail message recipient has opened the electronic mail message, as positively claimed by the Applicant. Specifically, Applicant's independent claims 9 and 15 positively recite:

9. A method for providing electronic mail message return receipts, the method comprising:

determining when an electronic mail message recipient has started reading an electronic mail message which requires an electronic mail message return receipt;

taking video of the electronic mail message recipient when the electronic mail message recipient has opened the electronic mail message;

determining when the electronic mail message recipient has stopped reading the electronic mail message; and

providing the video of the electronic mail message recipient back to the electronic mail message's originator who specified the electronic mail message return receipt requirement. (Emphasis Added.)

15. A method of providing electronic mail message return receipts between electronic mail correspondents, the method comprising:

receiving an electronic mail message having return receipt specified for the electronic mail message by a sender of electronic mail message;

providing the electronic mail message to at least one designated electronic mail message receiver;

determining when the at least one electronic mail message receiver opens the electronic mail message;

capturing the at least one electronic mail message receiver on video upon opening of the electronic mail message by the electronic mail message receiver;

and

providing an electronic mail message return receipt to the sender of the electronic mail message, wherein the electronic mail message includes the video of the at least one electronic mail message receiver reading the electronic mail message. (Emphasis Added.)

Cohn simply does not teach or suggest the novel concept of a method of providing electronic mail message return receipts, that determines when a electronic mail message recipient has started reading an electronic mail message and takes video of the electronic mail message recipient when the electronic mail message recipient has opened the electronic mail message. Rather, Cohn teaches a system that stores pre-

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recorded video of subscribers for identification confirmation. (See Cohn, Col. 32, Lines 15-27.) This deficiency is not bridged by the teaching of Cleron because Cleron only teaches the ability to capture video in a browser-based email system using a hypertext link to capture video through a video input or television signal. (See Cleron, Col. 5, Lines 32-35.) The Examiner's attention is directed to the fact that Cleron fails to teach, suggest or provide motivation for utilizing the ability to capture video in an electronic mail message return receipt.

In arguendo, even if Cohn and Cleron were combined, the combination would still not teach or suggest Applicant's invention. The combination of Cohn and Cleron would only teach a browser-based email system that has the ability to capture video using a hypertext link; wherein the browser-based email system would be capable of identification confirmation based on stored data of a subscriber's user profile. Therefore, the combination of Cohn and Cleron does not teach or suggest Applicant's invention as recited in independent claims 9 and 15.

Dependent claims 10-11, 13-14 and 16-20 depend from claims 9 and 15, respectively, either directly or indirectly and recite additional limitations. As such, and for the exact same reason set forth above, the Applicants submit that claims 10-11, 13-14 and 16-20 are also not made obvious by the teachings of Cohn and Cleron. As such, the Applicant respectfully requests the rejection be withdrawn.

C. Claim 12

The Examiner has rejected claim 12 in the Office Action under 35 U.S.C. § 103 as being obvious over Cohn, in view of Cleron, and further in view of "Official Notice." Applicant respectfully traverses the rejection.

The teachings of Cohn and Cleron have been discussed above. The Applicant respectfully submits that the Examiner has not taken "Official Notice" properly in accordance with MPEP §2144.03 Section A. The Applicant respectfully asserts that, given the fact there is no prior art that discloses a method of providing electronic mail message return receipts, that determines when a electronic mail message recipient has started reading an electronic mail message and takes video of the electronic mail message recipient when the electronic mail message recipient has opened the

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electronic mail message, as recited in independent claim 9, the additional limitations in dependent claim 12 are not "well known" or "common knowledge in the art capable of instant and unquestionable demonstration as being well-known." (See MPEP 8th Ed., 2100-136, Right Column, Lines 4-9.) Furthermore, in accordance with MPEP §2144.03, Section C, the Applicant respectfully requests the Examiner to produce authority for his statement.

In arguendo, even if "Official Notice" is proper, the "Official Notice" fails to bridge the substantial gap left by Cohn and Cleron. Specifically, Cohn and Cleron simply do not teach or suggest the novel concept of a method of providing electronic mail message return receipts, that determines when a electronic mail message recipient has started reading an electronic mail message and takes video of the electronic mail message recipient when the electronic mail message recipient has opened the electronic mail message. Rather, Cohn merely teaches a system that stores pre-recorded video of subscribers for identification confirmation. (See Cohn, Col. 32, Lines 15-27.) Furthermore, Cleron merely teaches the ability to capture video in a browser-based email system using a hypertext link to capture video through a video input or television signal. (See Cleron, Col. 5, Lines 32-35.) This deficiency is not bridged by the "Official Notice" because the "Official Notice" is only in reference to signaling stoppage of filming.

Dependent claim 12 depends from claim 9 and recites additional limitations. As such, and for the exact same reason set forth above, the Applicant submits that claim 12 is also not made obvious by the teachings of Cohn, Cleron and the "Official Notice." As such, the Applicant respectfully requests the rejection be withdrawn.

Conclusion

Thus, the Applicant submits that all of these claims now fully satisfy the requirement of 35 U.S.C. §102 and §103. Consequently, the Applicant believes that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring the issuance of a final action in any of the claims now pending in the application, it is

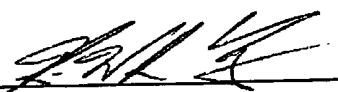
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requested that the Examiner telephone Mr. Kin-Wah Tong, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

1/18/05
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